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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,906	10/05/2000	Chan Daigle	25791.37.02	8824

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EXAMINER
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NICHOLSON, ERIC K

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 08/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/679,906

Applicant(s)

DAIGLE ET AL.

Examiner

Eric K Nicholson

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7, 28-30 and 37-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 28-30 and 37-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 17, 18. 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 2, 2003 has been entered.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the expanded tubular members of claims 1 and 46 must be shown and the threaded end portions being of greater inner diameter than the tubular members of claim 44 also must be shown or the features canceled from the claims. No new matter should be entered. This is the second objection to the drawings, applicant's statement of May 20, 2003 that figs. 2 and 3 illustrate the expanded members is not agreed with by the examiner. Figure 2 merely illustrates the two threaded members with no way of determining that they are or were expanded and Figure 3 illustrates two tubular

members being expanded via cone 310 however nowhere is the threaded connection seen expanded.

In view of the newly cited and applied art the previous notice of allowability of claims 7,37,42,43 and 47-58 is withdrawn. The delay in citing this art is regretted.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7,28,29 and 30 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-10 of copending Application No. 10/331718. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: Expandable tubular members having a pair of threaded portions coupled to one another and a quantity of sealant within the threaded portions of the tubular members. Although the conflicting first claims of each application are not identical, they are not patentably distinct from each other because the sealant of 10/331718 of 10/3317718 also possesses the characteristic of adhering to the threaded portions as made known by the specification. Dependent claims 2-7,28,29 and 30 of the present invention are identical to claims 2-10 of application 10/3317718.

**Claim Rejections – 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7,28-30 and 37-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,409,175 to Evans et al. in view of the Jet-Lok product catalog and applicant's disclosure of Jet-Lok on page 7 of the specification. The Evans et al. coupling illustrates in figures 8-10 the claimed invention of a pair of radially expanded tubular members 33,34 having radially expanded threaded portions as clearly shown and coupled to one another and including a seal 39 at either end within the radially expanded threaded portions of the radially expanded tubular members. As to claim 42 see figure 10 which illustrates the expansion cone that deforms the threaded members. However the

seals 39 do not adhere nor are they coated on the threads of the coupling members. The Jet Lok product catalog discloses that it is known in the art to use Jet-Lok sealant on threaded pressure fittings (page 3) and also to use cleaners or primers to prepare surfaces for the adhesives (page 4). Thread sealants are commonly used in the art to aid in locking and sealing threaded connections in order to give resistance to coming unthreaded due to vibration, high temperature and pressures. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute or supplement the seals 39 of Evans et al. with the Jet-Lok sealant, which as noted in the specification includes all of the characteristics of claims 2-7, 37, 48-52, 60-64, and further, as to claims 7, 53-67 to clean or prime the threaded surfaces with primer as noted on page 4 of the Jet-Lok catalog in order to speed cure time for the sealant adhesive. The sealant providing a more secure coupling for the threaded members due to its ability to resist vibrations, high temperatures and pressure.

### **Conclusion**


Applicant's arguments with respect to claims 1-6, 26-30 and 44-46 have been considered but are moot in view of the new grounds of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Nicholson whose telephone number is (703) 308-0829. The examiner can normally be reached on Tuesdays thru Fridays from 7:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne, can be reached on (703) 308-1159. The fax phone number for Technology Center 3600 is (703) 872-9326 for "before final" papers and (703) 872-9325 for "after final" papers.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center receptionist whose telephone number is (703) 308-1113.

ekn  
8/8/03

  
**Eric K. Nicholson**  
**Primary Examiner**  
**Technology Center 3600**